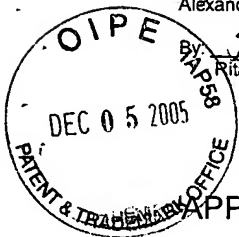


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By: *Rita M Sulic*
Rita M Sulic



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) : Edward A. Enyedy, et al.

TITLE : WELDING WIRE FEEDER AND
MOTOR THEREFOR

APPLICATION NO. : 10/687,170

FILED : October 17, 2003

CONFIRMATION NO. : 1901

EXAMINER : Thanh Lam

ART UNIT : 2834

LAST OFFICE ACTION : August 29, 2005

ATTORNEY DOCKET NO. : LEE 2 00336

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection issued in connection with the above-identified patent application. This Request, which is being filed concurrently with a Notice of Appeal, is requested for the reasons stated in the following paragraphs. An Amendment After Final Rejection canceling claim 21 is being filed herewith.

Claim 1

As discussed more fully on pages 6-8 of Applicant's Response to Office Action (faxed to the USPTO on July 28, 2005), Applicant respectfully submits that the Examiner clearly erred in rejecting claim 1 as obvious under §103. More particularly, no

comprehensible statement of motivation has been provided and/or no evidentiary basis supporting a statement of motivation has been provided by the Examiner in his rejection of claim 1.

Specifically, the Examiner stated the following in his rejection of claim 1:

3. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art hereinafter 'APA (fig. 1 of the application) in view of Yamada et al. (4,827,897).

Regarding claims 1,18,21-22, APA discloses all the aspect of the claimed invention except for a third brush circumferentially spaced from said first brush a second annular distance around said commutator and connectable to said second lead to cause said motor to rotate at a second speed to drive said rolls at a second speed, and a switching circuit with an operative condition to connect said second lead to a selected one of said second and third brushes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an additional bush (third brush) to the APA in order accommodate arrangement of Yamada et al. as describes above that would provide the motor easily change the rotation of the speed.

(emphasis added) *See final Office Action at pg. 4.* Applicant respectfully submits that this statement is incomprehensible and cannot stand to support a §103 rejection of claim 1.

On its face, the statement appears to assert that one skilled in the art would be motivated to modify the wire feeder motor arrangement of Applicant's Figure 1 with the teachings of Yamada "in order [to] accommodate [the] arrangement of Yamada et al." In other words, the Examiner is stating the it is obvious to combine reference B with reference A in order to accommodate the arrangement of reference B." This is a circular argument and fails to show that one skilled in the art would look to Yamada et al. to improve the wire feeder motor arrangement of Figure 1.

The Examiner may also be stating that the modification is obvious because it would provide a motor that is easy to have its rotational speed changed. While this is true, this is the advantage realized by the Applicant. The Examiner is unfairly taking an advantage gained by and realized by the invention of claim 1 and attempting to use it as a motivation to combine Yamada with Applicant's Figure 1. This is akin to stating that the engine driven automobile was obvious simply because it was desirable to go faster

than the prior art, e.g., a horse drawn buggy, permitted. Applicant submits that this too is an improper statement of motivation.

Irrespective of what exactly is meant by the Examiner's statement, Applicant asserts that the Examiner has provided no evidence to support a purported motivation. In response to Applicant's earlier challenge to the Examiner's lack of evidence supporting a motivation to combine, the Examiner had this to say:

2. In response to applicant's argument that "Examiner has impermissibly concluded that claim 1 is obvious in view of a combination of FIGURE 1 and Yamada et al. without any legitimate support on the record" there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the record is clearly shown by combined the two cited references, and regarding motivation is support a phase underlined above.

See *final Office Action* at pg. 2-3. Again Applicant has difficulty understanding the Examiner, but asserts that the Examiner has not met his burden in evidencing a motivation to combine.

Simply stating that the motivation is in the knowledge generally available to one of ordinary skill in the art is legally insufficient to evidence motivation to combine. If the Examiner takes the position that combining the teachings of Figure 1 and Yamada is obvious because there is some teaching, suggestion, or motivation to combine these teachings in the knowledge generally available to one of ordinary skill in the art, the Examiner still has the burden of evidencing that this is so. In other words, the Examiner has the burden of showing (i.e., point to evidence) that there is some teaching, suggestion, or motivation in the knowledge generally available to one of ordinary skill in the art to combine the teachings of Figure 1 and Yamada et al.. In this case, the Examiner has cited no such evidence.

Claims 2-17 depend from claim 1 and would be allowable if claim 1 was allowable.

Dependent Claim 4

Dependent claim 4 calls for the controller output signal of claim 1 to be caused by an input signal indicative of wire size. In rejecting claim 4, the Examiner stated:

Regarding claim 4, the proposal in combination of the APA and Yamada et al.
disclose said controller (20) output signal is caused by an input signal indicative of wire
size.

See final Office Action at pg. 4. Applicant respectfully submits that the limitation of claim 4 calling for the controller output signal of claim 1 to be caused by an input signal indicative of wire size is clearly not present in the applied combination of APA and Yamada et al. The Examiner's statement that APA and Yamada et al. disclose controller (20) output signal is caused by an input signal indicative of wire size is plainly inaccurate. Reference numeral 20 in Applicant's Figure 1 is associated with a change gear box. *See also Application pg. 6, lines 1-14.*

Dependent claims 5-8

Dependent claims 5-8 each call for the wire feeder of claim 1 to include a fixed ratio gear reducer between the motor and the feed rolls. In rejecting these claims, the Examiner states:

Regarding claims 2-8, the proposal in combination of the APA and Yamada et al.
disclose said wire feeder include: a fixed ratio gear reducer (20 of APA) between said
motor and said feed rolls.

See final Office Action at pg. 5. As indicated in the preceding section, this is clearly inaccurate. Element 20 in Figure 1 is associated with a "CHANGE GEAR BOX," not a fixed ratio gear reducer. This is indicated in the Figure itself and in the specification at page 6, lines 1-14. Fixed gear reducer 50 is shown in the wire feeder motor arrangement of Figure 2, which is not prior art.

Dependent claims 9-12

Dependent claims 9-12 each call for a time delay to be employed when the second brush of claim 1 is selected. The Examiner summarily states that this limitation is found in the applied references. Specifically, the Examiner states:

Regarding claims 9-12, the proposal in combination of the APA and Yamada et
al. disclose said switching circuit when in the condition to select said second brush has
a time delay (52) for selecting said third brush for a time (51) before selecting said
second brush.

See *final Office Action* at pg. 5. Again, this is plainly false. Reference numerals 51 and 52 of Yamada et al. are associated with relays (see col. 6, lines 21+ of Yamada et al.). There is no disclosure or even a remote suggestion of the relays 51,52 of Yamada et al. being used to delay selection of one of the brushes when another is already selected.

Claim 22

Claim 22 calls for a "device to change the annular distance to change the speed of said motor driving said feed rolls." This limitation is clearly not present in the applied combination of references and is not even found in the Examiner's rejection of claim 22. Rather, the Examiner only stated:

Regarding claims 1,18,21-22, APA discloses all the aspect of the claimed invention except for a third brush circumferentially spaced from said first brush a second annular distance around said commutator and connectable to said second lead to cause said motor to rotate at a second speed to drive said rolls at a second speed, and a switching circuit with an operative condition to connect said second lead to a selected one of said second and third brushes.

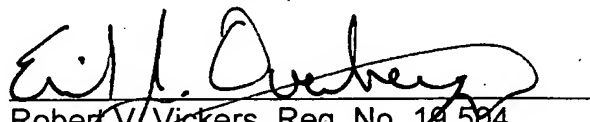
It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an additional bush (third brush) to the APA in order accommodate arrangement of Yamada et al. as describes above that would provide the motor easily change the rotation of the speed.

Thus, the Examiner has failed to even allege that a limitation of claim 22 is contained within the combination of references used to reject claim 22.

For all the reasons discussed above, Applicant respectfully requests a pre-appeal review and requests the instant application be allowed on the currently pending claims.

Respectfully submitted,
FAY, SHARPE, FAGAN,
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November 29, 2005


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